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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,389	10/27/2003	Kassab Al-Mahareeq	03/09-01	1646
61365 7590 09/17/2008 OVERHAUSER LAW OFFICES, LLC DOCKETING DEPARTMENT 737 W. GREEN MEADOWS DRIVE, SUITE 300 GREENFIELD, IN 46140				
EXAMINER				
NAGPAUL, JYOTI				
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1797				
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09/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/693,389

Applicant(s)

AL-MAHAREEQ ET AL.

Examiner

JYOTI NAGPAUL

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

Rejection of Claims 4 and 6 as being anticipated by Yonkers (US 4599220) has been modified in light of applicant's amendments.

Rejection of Claims 2 and 5 as being unpatentable over Yonkers (US 4599220) has been modified in light of applicant's amendments.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants' have amended the claims to recite "the pipette tip mounting shaft configured to alternatively engage and retain a pipette tip of a first diameter and a pipette tip of a second diameter", "a first sealing zone selectively engaged with the pipette tip of a first diameter" and "a second sealing zone being coaxial with the first sealing zone, selectively engaged with the pipette tip of a second diameter". Applicants' have amended the claims to be indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recitations either appear to be reciting both of the pipette tips are engaged on the mounting shaft which is not possible or the "alternative" language requires one tip to be engaged at a time. Therefore, the claim language is unclear and indefinite. Clarification is needed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

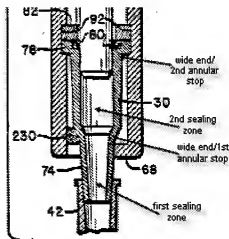
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 4 and 6** are rejected under 35 U.S.C. 102(b) as being anticipated by Yonkers (US 4599220).

5. Yonkers teaches a multi-channel pipetter. Yonkers teaches a mounting shaft (30) configured to alternatively engage and retain a pipette tip of a first diameter and a pipette tip of a second diameter. More specifically, the first sealing zone of Yonkers is configured to alternatively engage and retain a pipette tip of a first diameter and a pipette tip of a second diameter. The first sealing zone of Yonkers is conical and therefore is configured to retain a pipette tip of a first or second diameter. Yonkers teaches a first sealing zone comprising upper and lower ends. According to Figure 3, it appears the upper and lower ends are at an angle of 84 to 90 degrees with respect to the plane perpendicular to axis of the first sealing zone. Yonkers further teaches a second sealing zone being coaxial with the first sealing zone. The second sealing zone comprises upper and lower ends. According to Figure 3, it appears the upper and lower ends are at an angle of 84 to 90 degrees with respect to the plane perpendicular to axis of the second sealing zone. Yonkers further teaches a first annular pipette tip stop between and abutting and being coaxial with the first and second sealing zones. The first annular pipette tip stop being substantially perpendicular to the axis defining the

first and second conically tapered sealing zones. According to Figure 3, the first annular pipette tip stop has an inner diameter equal to the top end of the first sealing zone and an outer diameter to the lower end of the second sealing zone. Yonkers further teaches a second annular pipette tip stop abutting the second sealing zone. The second annular is perpendicular to the axis defining the first and second conically tapered sealing zones. According to Figure 3, the second annular pipette tip stop has an inner diameter equal to the top end of the second sealing zone. According to Figure 3, a third sealing zone (the area of 78) and having a third pipette tip stop defined at an upper end of the third sealing zone (the area of 78).



Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 2 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonkers (US 4599220).

Refer above for the teachings of Yonkers.

Yonkers fails to teach first sealing zone comprising a narrow end with an *outer diameter of 0.18 to 0.20 inches*, a wide end with an *outer diameter of 0.20 to 0.22 inches* and being *0.10 to 0.15 inches long*, to thereby form a tapered at an angle of 84 to 90 degrees with respect to the plane perpendicular to the axis of the first sealing

zone. Yonkers further fails to teach a second sealing zone comprising a narrow end with *an outer diameter of 0.22 to 0.24 inches*, a wide end with an outer diameter of *0.24 to 0.26 inches* and being *0.13 to 0.17 in. long*.

It would have been obvious to a person of ordinary skill in the art to modify the device of Yonkers to provide a first sealing zone comprising a narrow end with an *outer diameter of 0.18 to 0.20 inches*, a wide end with an *outer diameter of 0.20 to 0.22 inches* and being *0.10 to 0.15 inches long* and a second sealing zone comprising a narrow end with *an outer diameter of 0.22 to 0.24 inches*, a wide end with an outer diameter of *0.24 to 0.26 inches* and being *0.13 to 0.17 in. long* in order to create a fluid tight seal between the tip and shaft and obtain the desired lateral stability for tip on the shaft. See *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Response to Arguments

5. Applicant's arguments filed on September 8, 2008 have been fully considered but they are not persuasive. Refer to the rejection above for the arguments/remarks addressing a mounting shaft configured to alternatively engage and retain a pipette tip of a first diameter and a pipette tip of a second diameter. Examiner further suggests applicants' recite a limitation where the pipette tip abuts the 1st annular pipette tip stop.

Additionally, applicants' argue that the first annular pipette tip stop is not **substantially perpendicular** to the axis defining the first and second conically tapered sealing zones. Examiner respectfully disagrees. Applicants' have not clearly recited what is deemed to be substantially perpendicular. Further, no standard has been recited to determine what is or what not is **substantially perpendicular**. Therefore, it is the examiner's position that Yonkers teaches a first annular tip stop is substantially perpendicular to the axis defining the first and second conically tapered sealing zones.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI NAGPAUL whose telephone number is (571)272-1273. The examiner can normally be reached on Monday thru Friday (10:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.